

REMARKS/ARGUMENTS

The Applicant has carefully considered this application in connection with the Examiner's Action and respectfully requests reconsideration of this application in view of the following remarks.

The Appellants originally submitted Claims 1-35 in the application. In response to an Office Action dated May 1, 2002, the Appellants elected to prosecute the invention of a method Group I, namely Claims 1-28. In response to a subsequent Office Action, the Appellants have amended Claims 1, 4, 10, 12-14, 23 and canceled Claims 2-3, 6-7, 10 and 15-16, 18-19 and 25 without prejudice or disclaimer. Accordingly, Claims 1, 4-5, 8-9, 11-14, 17, 20-24 and 26-28 are currently pending in the application.

I. Rejection of Claims 1, 4-5, 8-9, 11-14, 17, 20-24 and 26-28 under 35 U.S.C. §103

The Examiner has rejected Claims 1,4, 5, 8, 11-14, 17, 20, 22-24, 26 and 28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,355,498 to Chan *et al.* ("Chan") in view of U.S. Patent No. 5,067,004 to Marshall *et al.* ("Marshall"). The Examiner also rejected Claims 9, 21 and 27 under 35 U.S.C. §103(a) as being unpatentable over Chan in view or Marshall and further in view of U.S. Patent No. 5,692,279 to Mang *et al.* ("Mang"). The Applicant respectfully disagrees.

The asserted combination fails to establish a *prima facie* case of obviousness for the reason that Chan is an improper reference because it is excluded under 35 U.S.C. §103(c) from being used in a rejection under 35 U.S.C. 103(a) against the Claims of the present application. The Applicant notes that, as indicated on Page 9 of the present application, Chan (Application No. 09/637,069) was filed on August 11, 2000 and was co-pending with the present application, which, in turn, was filed

on November 17, 2000. Moreover, Harold Huggins is an inventor in both Chan and the present application. Therefore Chan only qualifies as prior art under 35 U.S.C. 102(e).

The Applicant wishes to direct the Examiner's attention to Exhibit A, enclosed with the present response, indicating that the assignee in Chan was Lucent Technologies Inc. and was subsequently transferred to Agere Systems Guardian Corporation on January 30, 2001, which was merged into Agere Systems, Inc., which is the present owner of the present application and Chan. As already provided in the record and reproduced in Exhibit B, enclosed with the present response, the present application at the time of filing, was also assigned to Lucent Technologies Inc. and was subsequently transferred to Agere Systems Guardian Corporation also on January 30, 2001. Thus, at the time the present invention was made, Chan and the present invention were owned by the same entity, Lucent Technologies Inc. and both were ultimately assigned to Agere Systems, Inc.

Due to this co-ownership and the fact that Chan is a 102(e) reference, Chan must be excluded as prior art under 35 U.S.C. §103(c). Accordingly, the asserted combinations of Chan in view of Marshall or Chan in view of Marshall and further in view of Mang are improper.

Furthermore, Marshall, the remaining reference in the Examiner's combination does not teach or suggest all elements in the claim inventions of the present application, inasmuch as Marshall was merely cited for the proposition of suggesting a space between vias of 42 microns. Nor does Mang cure the deficit teachings of Marshall, inasmuch as Mang was merely cited for the proposition of forming a dielectric layer of silicon oxide or SiN. Therefore independent Claims 1, 14 and 23 their dependent claims are not obvious in view of Marshall either alone or in combination with Mang.

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1, 4-5, 8-9, 11-14, 17, 20-24 and 26-28 under 35 U.S.C. §103(a). The Applicant therefore respectfully requests the Examiner withdraw the rejection.

II. Conclusion

In view of the foregoing amendment and remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a timely Notice of Allowance for Claims 1, 4-5, 8-9, 11-14, 17, 20-24 and 26-28.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "Charles W. Gaines", written in a cursive style.

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